

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kalpana Kamath et al.
Serial No. : 10/814,079
Filed : March 30, 2004
Title : EMBOLIZATION

Art Unit : 1793
Examiner : Pegah Parvini
Conf. No. : 5482

Mail Stop Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO ADVISORY ACTION OF JUNE 26, 2009

Applicants incorporate herein by reference their arguments submitted in the Amendment mailed June 12, 2009.

In the Advisory Action, the Examiner maintains an “all silica particles” are alike mentality by maintaining that, irrespective of the vastly different manner in which Chevallier and Mangin use their respective particles and without any evidence to support his conclusion, it would have been obvious to one skilled in the art to modify Chevallier's particles (which have nothing whatsoever to do with embolization) based on Mangin (which has nothing whatsoever to do with Chevallier's reinforcing filler in elastomers). *See* Advisory Action, p. 2. This is clearly an improper hindsight construction on the part of the Examiner. Simply put, one skilled in the art, starting with Chevallier, would not have found it obvious to look to Mangin to modify Chevallier to provide the subject matter covered by the claims.

The Examiner cites MPEP §2145 in an attempt to shift the burden to Applicants' to disprove the Examiner's tenuous obviousness argument. *See id.* Applicants remind the Examiner that MPEP §2145 refers to a shifting of the burden “*if a prima facie case of obviousness is established*” *See* MPEP §2145. Because the Examiner has not properly established a prima facie case of obviousness, it is improper for the Examiner to try to shift the burden to Applicants in the manner indicated in the Advisory Action.

The Examiner appears to attempt to dodge the issue of inherent disclosure by making up his own law on the issue. Indeed, the Examiner is exactly wrong in his attempt to demonstrate

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inherent disclosure based on Mangin allegedly "broadly includ[ing] any and all silica particles." *See id.* Applicants again refer the Examiner to MPEP §2112, which provides the requisite burden to meet to establish inherent disclosure. The Examiner simply has not met this burden with regard to establishing that either Chevallier or Mangin, or their purported combination, inherently discloses the particles required by the claims. For example, the Examiner has not met the burden of establishing that either Chevallier or Mangin, or their purported combination, inherently discloses a plurality of substantially spherical porous silica particles having a pore volume distribution such that about 70% or more of the pore volume of the plurality of substantially spherical porous silica particles is made up of pores having pore diameters which have a tolerance of about 10 nm or less on the mean pore diameter.

In view of the foregoing, Applicants request reconsideration and withdrawal of the rejections of the claims.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: August 5, 2009

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